IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Frederick Morello et al.	Confirmation No.:	2229
Serial No.:	09/896,365	Art Unit:	3633
Patent No.:	8,033,070	Examiner:	Jeanette Chapman
Filed:	June 29, 2001	Granted:	October 11, 2011
For:	Building Panel and Panel Crimping Machine	Attorney Docket No.:	011925-0057-999

APPLICATION FOR PATENT TERM ADJUSTMENT

UNDER 37 C.F.R. §§ 1.705(d) AND 1.705(b)

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 C.F.R. §§ 1.705(d) and 1.705(b), Applicants request reconsideration of the patent term adjustment indicated on the face of the above-noted granted patent. Entry and consideration of the remarks made herein into the record of the instant application are respectfully requested.

In accordance with 37 C.F.R. §§ 1.705(b)(1) and 1.18(e), it is believed that the required fee for filing this application is $200.00. The Commissioner is hereby authorized to charge the required fee(s) to Jones Day Deposit Account No. 50-3013, including any additional fees that may be required by this paper.

REMARKS

On June 7, 2011, the Office mailed a Notice of Allowance for the above-captioned application along with a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) ("Determination of PTA") indicating that the patent term adjustment (PTA) to date was 0 days. The above-captioned application issued on October 11, 2011, with an indicated PTA of 392 days.

A request for consideration of additional PTA is hereby made, and pursuant to 37 C.F.R. § 1.705(b)(2), the following statement of facts is submitted in support of this request.

During the prosecution of this application, two Notices of Appeal were filed, and each was followed with briefing. The first Notice of Appeal was filed on 8/20/2004, and following briefing, the Examiner ultimately reopened prosecution by mailing a new non-final rejection on 11/17/2006. The second Notice of Appeal was filed on 11/19/2010, and following the filing of an Appeal Brief, the Examiner issued a Notice of Allowance on 06/07/2011.

A Federal Register Notice was published on April 6, 2011, indicating the Office's proposal to change the rules of practice relating to "Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review and Information Disclosure Statements." Federal Register, Vol. 76, No. 66, 04/06/2011, pp. 18990-18995. In that Notice, the Office indicated its intent regarding a proposal relating to PTA in appellate review as follows:

> The Office is proposing to change the rules of practice to indicate that in most circumstances an examiner reopening prosecution of the application after a notice of appeal has been filed will be considered a decision in the review reversing an adverse determination of patentability for purposes of patent term adjustment or extension purposes. Therefore, in such situations, patentees would be entitled to patent term extension or adjustment.

Id. at p. 18990.

The Office's prior positions on PTA involving appellate review did not permit PTA in the instance of an examiner reopening prosecution after the filing of a Notice of Appeal, as reflected in the same Federal Register Notice, notably:

> Under the patent term adjustment final rule published in 2000, the Office initially stated that for a decision by the BPAI to be "a decision in the review reversing an adverse determination of

> patentability'' within the meaning of 35 U.S.C 154(b)(1)(C)(iii), the decision must sustain or reverse the rejection(s) of claims(s) on appeal. *See* Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 FR at 56368. The Office further stated that a remand or other administrative order by the BPAI even if by a merits panel would not be considered ''a decision in the review reversing an adverse determination of patentability'' in the 35 U.S.C. 154(b)(1)(C)(iii). *See id.* at 56369.

See Federal Register, Vol. 76, No. 66, 04/06/2011, p. 18991.

However, as noted above, the Office has published a proposal to permit PTA in instances where the examiner reopens prosecution after the filing of the Notice of Appeal, and the Office's proposal was stated as follows:

> Section 1.702: Section 1.702(e) is proposed to be amended to take into account the situation in which the Office reopens prosecution after a timely notice of appeal has been filed but before any decision by the BPAI and issues an Office action under 35 U.S.C. 132 (i.e., a new non-final or final Office action) or notice of allowance under 35 U.S.C. 151. The reopening of prosecution in this situation will in most circumstances also be considered a decision by the BPAI as that phrase is used in 35 U.S.C. 154(b)(1)(A)(iii), a decision in the review reversing an adverse determination of patentability as that phrase is used in 35 U.S.C. 154(b)(1)(C)(iii), and a final decision in favor of the applicant under § 1.703(e). An examiner's answer containing a new ground of rejection is not an Office action under 35 U.S.C. 132, and is not the Office reopening prosecution. Section 1.702(e) is further amended by adding a sentence to provide that a reopening of prosecution after a notice of appeal has been filed will not be considered a decision in the review reversing an adverse determination of patentability as provided in § 1.702(e) if appellant files a request to withdraw the appeal, an amendment pursuant to § 41.33 canceling all of the claims on appeal, or a request for continued examination under 35 U.S.C. 132(b).

Id. at p. 18993.

The period of adjustment would be given by the number of days between and including the filing date of the Notice of Appeal and the mailing of the action of notice of allowance:

> The period of extension or adjustment calculated under 37 CFR 1.701(c)(3) or 1.703(e) (as applicable) would equal the number of days in the period beginning on the date on which a notice of appeal to the BPAI was filed under 35 U.S.C. 134 and 37 CFR

> 41.31 and ending on the date of mailing of the Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

Id. at p. 18992.

On December 1, 2011, the Federal Register published the USPTO "Revision of Patent Term Adjustment Provisions Relating to Information Disclosure Statements." Federal Register, Vol. 76, No. 231, 12/01/2011, pp. 74700-74703. While that Notice provided amended rules effective December 1, 2011 for determining PTA in certain instances involving information disclosure statements, that Notice did not include amended rules addressing PTA determinations involving appellate review, in particular, in the situation where the examiner reopens prosecution following the filing of a notice of appeal. That Notice indicated that the Office was revising its proposal for that situation for publication in a separate rule making:

> The Office is revising its proposal concerning the reopening of prosecution of an application by the Office after a notice of appeal has been filed and will publish that proposal for public comment in a separate rulemaking.

Id. at 74701.

It was hoped that the Office would have issued by now amended rules regarding the determination of PTA in instances where the examiner reopens prosecution after the filing of a Notice of Appeal. Nevertheless, in light of the Office's above-described intent to amend the rules of practice on this issue, and considering that the Office could conduct rule making for such rules relatively soon, this Application for Patent Term adjustment is respectfully being submitted within two months of the issue date of the above captioned patent per 37 C.F.R. 1.705(d) to express the belief that the instant patent should be accorded additional PTA as indicated below, upon the implementation of final rules by Office to permit PTA where the examiner reopens prosecution following the filing of a Notice of Appeal, to the extent such rules are consistent with the Office's above-described proposals on this issue.

(i) and (ii) *Correct Patent Term Adjustment and Relevant Dates*:

As indicated above, two Notices of Appeal were filed in the instant application, and each was followed with briefing. The first Notice of Appeal was filed on 8/20/2004, and following briefing, the Examiner ultimately reopened prosecution by mailing a new non-final rejection on 11/17/2006. The second Notice of Appeal was filed on 11/19/2010, and following the filing of an Appeal Brief, the Examiner issued a Notice of Allowance on 06/07/2011. The

duration from the first Notice of Appeal filed 8/20/2004 to the non-final Office Action mailed 11/17/2006 is believed to be 819 days. The duration from the second Notice of Appeal filed 11/19/2010 to the Notice of Allowance mailed 06/07/2011 is believed to be 200 days. The combined duration is 1019 days. It is believed that 1019 days of PTA should be added, upon implementation of final rules to provide additional PTA where an examiner reopens prosecution following a Notice of Appeal, to the extent consistent with the Office's stated intent and proposals as reflected above, bringing the total PTA for the instant patent to 1411 days (1019 days plus the 392 days already accorded).

(iii) *Terminal Disclaimer*:

The instant patent is not subject to a terminal disclaimer.

(iv) *Any Circumstances that may Constitute a Failure to Engage in Reasonable Efforts to conclude Processing or Examination of the Application as Set Forth in 37 C.F.R. § 1.704*:

For purposes of requesting additional PTA under anticipated amended rules relating to the examiner's reopening of prosecution after the filing of a Notice of Appeal as discussed above, it is believed that there were no circumstances that constitute a failure to engage in reasonable efforts to conclude processing or examination of the application. It is noted that the Board of Patent Appeals and Interferences (BPAI) mailed an "Order Returning Undocketed Appeal to Examiner" on 10/17/2005, on grounds that the Appeal Brief filed on 10/21/2004 was formatted according to 37 C.F.R. § 1.192(a) (which was abolished on 09/13/2004), and did not comply with newly implemented 37 C.F.R. § 41.37(c). However, in response to the 10/21/2004 Appeal Brief, the examiner mailed an Answer on 02/09/2005 instead of issuing a Notice of Non-Compliant Appeal Brief, and as a result, the Appeal proceeded normally until the BPAI Order was issued. As such, it is believed that there were no circumstances that constitute a failure to engage in reasonable efforts to conclude processing or examination of the application.

Accordingly, it is believed that 1019 days of PTA should be added to the instant patent, upon implementation of final rules that provide additional PTA where an examiner reopens prosecution following a Notice of Appeal, to the extent such rules are consistent with the Office's stated intent and proposals as reflected above, bringing the total PTA for the instant patent to 1411 days.

In accordance with 37 C.F.R. § 1.705(d), this application for patent term adjustment is being filed within two months of the grant date of the instant patent, and is believed timely given that the Office has not yet published final rules on the granting of PTA where an examiner reopens prosecution following the filing of a Notice of Appeal, though the Office has indicated its intent on the issue in the applicable Federal Register Notices of 04/06/2011 and 12/01/2011 as described above.

Applicants respectfully request approval and entry of the above remarks.

Respectfully submitted,

Date: December 12, 2011 — Douglas H. Pearson — 47,851

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